

## **REMARKS**

The following remarks are prepared in response to the Office Action mailed January 12, 2009. Claims 12 and 20-30 are currently pending in the present application.

### **HISTORY OF PROSECUTION**

Applicant filed this application almost 6 years ago with the U.S. PTO. It took U.S. PTO 2 years before the application was examined. The Examiner Talbot examined the application and issued an Official Action on April 4, 2005 rejecting the claims (which were broader than the current claims) based on U.S. Patent 1,380,716 to Herman in view of 228 to Linger. Applicant interviewed with the Examiner and Primary and distinguished the difference with the Examiners. The Examiners agreed and withdrew the rejection.

A new Office Action was issued on January 26, 2006 with new references and rejections. Again, the applicant's representative and applicant interviewed and distinguished the differences. This time the Primary Examiner, Wilmon Fridie (see interview summary of 06/26/06), indicated that if the applicant made certain amendments the claims would be allowed. Applicants did not believe the amendments were necessary, but made the amendments in order to expedite the prosecution and place the application in condition for allowance.

However, a new SPE, Monica Carter, was now responsible for over seeing Mr. Talbot and a new set of 112 rejections were now given. Even though the Examiner had examined the cases before and clearly understood the scope of the invention, he now was issuing 112 rejections. A couple of response went back and forth.

Six years later a new Examiner and SPE have been assigned to the case and now the same rejection which was issued 4 years ago is being reissued for claims that are much narrower in scope. As you can imagine applicant and applicant's representative are somewhat frustrated by the prosecution which has cost a lot of time and money for applicant.

As stated in first response applicant's claims are not anticipated or rendered obvious by the Herman. Applicant's invention includes a novel handpiece apparatus used for cutting tools which is able to accept all standard shank sizes from at least 1/16 to ~ inch. Furthermore, the present invention provides a shrouded/guarded adjustable 3 jaw key type chuck having a capacity up to 6.35 mm.

Herman discloses a ball bearing handpiece used for tools. First, Herman fails to disclose a shrouded chuck as recited in the independent claims. Second, the handpiece disclosed in Herman does not relate to the Jacob chuck as is disclosed in the present invention. Furthermore, there are no dimensions given in the Herman patent. The configuration and dimensions in applicant's invention are drastically different than in the Herman patent. For example, Herman fails to disclose or render obvious wherein the diameter of the second portion is less than the diameter of the first portion where in the first and second portion have a novel range in diameter, which allows for various sized chucks to be received.

**CONCLUSION**

The application is deemed to be in condition for allowance and an expedited notice to this effect is respectfully requested.

If there are any questions with regards to this response, or if the Examiner believes that a telephone interview will help further prosecution of the application, the Examiner is invited to contact the undersigned at the listed telephone number.

The Examiner is urged to contact Rouz Tabaddor at the number indicated below with any questions or concerns.

Respectfully submitted,

Dated: May 24, 2010

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